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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,635

07/17/2006

Pascal Arnaud

05725.1553

7496

22852 7590 02/17/2010
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EXAMINER

PURDY, KYLE A

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

02/17/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/565,635	Applicant(s) ARNAUD, PASCAL	
	Examiner Kyle Purdy	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/23/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-85 is/are pending in the application.
- 4a) Of the above claim(s) 61,64,65,67,68,83 and 85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-60,62,63,66,69-82 and 84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

1. The Examiner acknowledges receipt of the arguments filed on 11/23/2009.
2. Claims 47-60, 62, 63, 66, 69-82 and 84 are presented for examination on the merits. The following rejections are made.

Response to Applicants' Arguments

3. Applicants arguments filed 11/23/2009 regarding the rejection of claims 47-60, 62, 63, 66, 69-82 and 84 made by the Examiner under 35 USC 103(a) over Arnaud (US 2002/0058054) in view of Benitetz et al. (US 43327338) have been fully considered but they are not found persuasive.

4. The rejection of claims 47-60, 62, 63, 66, 69-82 and 84 made by the examiner under 35 USC 103(a) is **MAINTAINED** for the reasons of record in the office action mailed on 08/26/2009.

5. In regards to the 103(a) rejection, Applicant asserts the following:

A) Arnaud is directed to cosmetic compositions comprising non-volatile hydrocarbon oils, non-volatile silicone compounds and an inert particulate phase. The office fails to focus on the compositions as a whole and only focuses on the non-volatile hydrocarbon oil component alone. Thus, the prior art must be considered in its entirety, including disclosures that teach away from the claims;

B) Arnaud fails to recognize that particulate esters can overcome the disadvantages of silicone compounds present in combination with hydrocarbon oils. Moreover, the art fails to

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teach a composition which contains the particular ester alone without the presence of silicone compounds; and

C) One would not have been motivated to combine Arnaud and Benetiz as they are non-analogous art.

6. In response to A, it's not clear how Arnaud teaches away from Applicants invention. The instant claims are to a composition comprising a physiologically acceptable medium with a fatty phase comprising a particular ester. Arnaud teaches a composition comprising a physiologically acceptable medium containing a fatty phase with a particular ester. The fact that Arnaud includes other ingredients in their composition does not constitute a teaching away. Arnaud does not teach away because they 'do not criticize, discredit or otherwise discourage' the inclusion of a particular ester in to a physiologically acceptable composition. Actually, it's not even clear why Applicant can assert that Arnaud teaches away when the reference specifically suggests that the composition include such an ingredient.

7. In response to B, this is not persuasive. The instant claims are 'comprising' claims. Therefore, the claims are inclusive to other ingredients not specifically recited, such as non-volatile silicone compound. See MPEP 2111.03.

8. In response to C, it's acknowledged that Benetiz is not wholly directed to the same field of endeavor as Arnaud. It should be pointed out again that Benetiz cites US 4125549 which is directed to improving cosmetic properties with ester compounds. At the very least, Benetiz acknowledges that esters are useful in cosmetic compositions. Regardless, Arnaud teaches their composition is to comprise a non-volatile hydrocarbon oil which may be an ester in the form of a diester wherein the diester is derived from C₂₋₁₈ acids (i.e. neopentanoic acid) and C₂₋₈ polyols

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(neopentyl glycol). However, Arnaud fails to teach the specific species. Benetiz is directed to synthesis of various esters derived from neoacids (neopentanoic acid) and polyols (neopentyl glycol, encompassed by Markush structure). A person in possession of both Arnaud and Benetiz would have been motivated and capable of arriving at Applicants instant species with a reasonable expectation for success in improving the properties of the final composition.

Applicants arguments are not found persuasive.

Maintained Rejections, of Record
Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

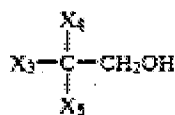
11. **Claims 47-60, 62, 63, 66, 69-82 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud (US 2002/0058054; published 05/16/2002) in view of Benitez et al. (US 4332738; published 06/01/1982).**

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12. Arnaud is directed to transfer-resistant cosmetic compositions comprising a variety of phases including a non-volatile silicone phase, a non-volatile hydrocarbon oil and an inert particular phase. It's taught that non-volatile hydrocarbon oil may be an ester in the form of a monoester, diester, and in general, polyesters (see [0078]). The esters are preferably branched and saturated and are preferably esters of C₂₋₁₈ acids and C₂₋₈ polyols (see [0079]). Exemplified and preferred esters include those derived from neopentanoic acid. Briefly, taught polyols include propylene glycol and neopentyl glycol (see [0079]). The ester is to be present in an amount of from 5-99% of the composition (see [0081]). In addition to the ester compound, the composition is to comprise a fatty constituent such as a mineral, animal or plant based oil (see [0083]). The composition is to also comprise a coloring agent in amount of between 0.01-70% (see [0098]). The composition is to also comprise a filler in an amount of between 0.1-30% (see [0096]). The composition is to also comprise a wax in an amount of between 0.01-50% (see [0105]). Moreover, the composition may be anhydrous (see [0035]).

13. Arnaud fails to explicitly teach neopentyl glycol dineopentanoate.

14. Benitez is directed to esterification of neoacids by the use of cation exchange resins. Benitez is useful because it teaches how to synthesize such neoesters such that the product is high purity and the process is high yield. Exemplified neoacids include neopentanoic and neodecanoic acids (see claim 5). These acids are taught to be esterified with either monohydric or polyhydric alcohols (see column 3). The generic polyhydric species is as follows:



X_{3, 4, 5} may be, among others, hydrogen or C₁₋₅ hydroxyalkyl, which encompasses neopentyl glycol. A particularly preferred polyol is that of pentaerythritol.

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15. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Arnaud and Benitez with a reasonable expectation for success in arriving at a composition comprising a fatty phase with a neopentanoic acid ester such as neopentyl glycol dineopentanoate. One would have been motivated to use the generic class of neopentanoic acids esters in the composition of Arnaud for several reasons. First, Arnaud while not specially teaching such a compound discloses both of the individual agents required to create the instant ester. Any person of ordinary skill in the art would have been capable of utilizing the preferred neopentanoic acid and esterifying it with the exemplified polyol, neopentyl glycol. Such a basic undertaking would result in a composition with the instantly claimed compound. Second, the instantly claimed species is encompassed by the teaching of Benitez which is directed to the manufacture of neoacid esters. It is acknowledged that Benitez does not explicitly disclose the instantly claimed species. However, it would have been well within the purview of an ordinary person, especially in view of Arnaud, to arrive at the instant compound. It's noted that Benitez is largely directed to the synthesis of neoacid esters, without any real purpose. However, Benitez incorporates various references (see column 1, for example) which are directed to the use of neoacids for use in cosmetic compositions to improve the properties thereof. Thus, while on its face Benitez is only drawn to synthesis of neoacids, Benitez as a whole would readily suggest to any ordinary person to use the disclosed neoacids in cosmetic compositions in order to improve the properties thereof. Therefore, the invention as a whole is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kyle Purdy/

Examiner, Art Unit 1611

February 9, 2010

/David J Blanchard/

Primary Examiner, Art Unit 1643